UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,539	04/30/2001	David P. Vellante	ITC 2-001	3397

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EXAMINER
JABR, FADEY S

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/845,539	VELLANTE ET AL.
	Examiner	Art Unit	
	Fadey S. Jabr	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 June 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-14 and 29-49</u> is/are pending in the application.

4a) Of the above claim(s) <u>15-28</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-14 and 29-49</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims **1, 29 and 38** have been amended. Claims **1-14 and 29-49** remain pending and

are again presented for examination.

Response to Arguments

1.   Applicant's amendments filed 26 June 2006, with respect to the objection of claim 1,

have been fully considered and are therefore withdrawn.

2.   Applicant's arguments filed 26 June 2006, with respect to 35 U.S.C. 112, have been fully

considered and are therefore withdrawn.

3.   Examiner acknowledges receipt of the information sent by the Applicant in response to

the Requirement for Information Under 37 C.F.R. § 1.105.

4.   Applicant's arguments, with respect to the Nonstatutory Double Patenting rejection, have

been fully considered but the rejection is upheld.

5.   Applicant's arguments filed 26 June 2006, with respect to 35 U.S.C. 101 have been fully

considered and are persuasive. The rejection of claims **1-14 and 29-49** has been withdrawn.

6.   Applicant's arguments with respect to the Oath/Declaration have been fully considered

but the objection is upheld. The Oath/Declaration is still defective for failing to have all

inventors sign the Oath/Declaration.

7.   Applicant's arguments with respect to claims **1-14 and 29-49** have been considered but

are moot in view of the new ground(s) of rejection.

Drawings

The drawings were received on 26 June 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As per Claims **1-14 and 29-49**, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

        i. the utility need not be expressly recited in the claims, rather it may be inferred.

        ii. if the utility is not asserted in the written description, then it must be well

        established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir.

1994), the examiner will determine whether there is simply a mathematical construct

claimed, such as a disembodied data structure and method of making it. If so, the claim

involves no more than a manipulation of an abstract idea and therefore, is nonstatutory

under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable

of producing a useful result when it was fixed in a tangible medium, which enabled its

functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete"

result. Usually, this question arises when a result cannot be assured. An appropriate

rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection,

because the invention cannot operate as intended without undue experimentation.

As currently recited the claims appear to be nothing more than a series of deriving steps,

increasing and modifying a variety of values. While these steps may be useful, there does not

appear to be any tangible result. Consequently, the claims are non-statutory for failing to recite a

tangible result.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims **1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Feria et al.,

U.S. Patent No. 7,020,621 B1 in view of Abu El Ata et al., Pub. No. US2004/0249482 A1.

       As per **Claim 1 and 9-10**, Feria et al. discloses a method comprising:

-    deriving a base application value corresponding with the cost of an application use

     cost construct (C.1, lines 10-35);

-    deriving a business experience based coefficient for said cost construct derived in step

     (a), said coefficient representing the relative productivity contribution represented by

     said cost construct to said application (C. 1, lines 40-60);

-    uplifting said base application value to provide an actual application value for said

     application by generating the product of the value of said cost construct and said

     business experience based coefficient (C. 1, line 61 – C. 2, line 4);

Feria et al. fails to disclose increasing said actual application value by the value of the highest

optimized business value of a an enablement attribute construct of said application to provide a

maximum business value of said application; and modifying maximum said business value of

said application in correspondence with a derived operational cost of said application to derive

the net business value of said application as said organization specific value.

However, Abu El Ata et al. teaches business values that are associated with business infrastructure, where a ceiling threshold is a maximum a value can be. When a value is too low that value can be analyzed to determine which metrics are causing the low value (0053). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Feria et al. and include providing a ceiling threshold in which the business value can attain as taught by Abu El Ata et al., because it allows the user to determine a value that when reached can be analyzed to determine the cause of the threshold being reached.

As per **Claim 2**, Feria et al. discloses providing said application use cost construct as the cost of active concurrent users of the application (C. 1, lines 40-47).

As per **Claim 3**, Feria et al. discloses providing said application use cost construct as including the cost of said infrastructure corresponding with said application (C. 5, line 24-C. 6, line 9).

As per **Claim 4**, Feria et al. discloses providing said application use cost construct as including the cost of said support of the application use of said infrastructure (C. 8, lines 27-36).

As per **Claim 5**, Feria et al. fails to explicitly disclose providing said application use cost as said cost of active concurrent users of the application for a single working day. However, Feria et al. discloses determining the cost of each end user (C. 1, lines 40-47). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Feria et al. and include determining the cost of end users for any amount

of time, because it allows the user to determine value metrics on specified time metrics.

As per **Claim 6**, Feria et al. fails to explicitly disclose determining said enablement

attribute construct for said application as including the value of zero unavailability of said

application. However, Feria et al. discloses costs related to downtime and a downtime rate

associated with the application or network being unavailable (C. 9, line 61 – C. 10, line 16; C.

14, line 54 – C. 15, line 4). Therefore, it would have been obvious to one of ordinary skill in the

art at the time of applicant's invention to modify the method of Feria et al. and include

determining the downtime rate, because it provides a metric for measuring the unavailability of a

network.

As per **Claim 7**, Feria et al. discloses determining said enablement attribute construct for

said application as including the value of perfect flexibility of the application to subsume said

variation with zero latency (C. 17, lines 11-15).

As per **Claim 8**, Feria et al. discloses determining said enablement attribute construct for

said application as including the value of perfect security of the application when it has

subsumed said variation (C. 5, lines 63-67).

As per **Claim 11**, Feria et al. discloses deriving said operational cost of said application in correspondence with: the desk top cost of computer hardware and software; staff operational cost; the effective cost of computer hardware and software storage; and the effective cost of computer hardware and software servers (C.5, line 23 – C. 6, line 9).

As per **Claim 12**, Feria et al. discloses deriving said operational cost of said application in correspondence with: the effective cost of database software; the effective cost of application software; the effective cost of computer network hardware and software; and the effective cost of services (C 5, line 23 – C. 6, line 40).

As per **Claim 13**, Feria et al. discloses deriving said operational cost of said application in correspondence with line of business costs (C. 1, lines 40-47).

As per **Claim 14**, Feria et al. deriving said operational cost of said application in correspondence with information technology costs (C. 1, lines 40-47).

11.   Claims **29-33 and 36-49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Feria et al. U.S. Patent No. 7,020,621 B1.

As per **Claims 29 and 38**, Feria et al. discloses a method comprising:

-    deriving base application values corresponding with an application use cost construct for respective ones of said application (C. 1, lines 10-35);

- deriving a business experience base factor for each said cost construct derived in step

(a), each said factor representing the relative productivity contribution represented by

a said cost construct to its corresponding application (C. 1, lines 40-60);

- uplifting said base application value for each of said applications by operating upon

each with a said business experience based factor to provide actual application values

for each said application (C. 1, line 60 – C. 2, line 4).

Feria et al. fails to disclose deriving a potential business value for each of said applications by

operating upon each said actual application value with a value corresponding with a perceived

value of an enablement attribute construct corresponding with said variation; and (e) deriving a

said net business value for each said application by deriving and removing the operational cost of

the corresponding said application from a respective said potential business value.

However, Feria et al. discloses a system which determines and assesses the added value

from potential changes that are made to the information technology, where base and ongoing

costs are both calculated in association with the IT (C. 2, lines 60 – C.3, line 67). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Feria et al. and include determining the added value of potential changes

to the system, because it allows the user to determine how certain changes to the system can

affect the total value of the system.

As per **Claims 30-31**, Feria et al. fails to explicitly disclose providing a sum of net

business values or providing a sum of net business values. However, Feria et al. discloses

budget value and total business budget value where the metrics can be used to provide

benchmarking and estimating guidelines for TCO (C. 10, line 54 - C.11, line 3). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Feria et al. and include determining the values of the budget and total

business budget values, because it provides a metric to determine the rate at which the company

is technology-oriented.

As per **Claim 32-33**, Feria et al. fails to explicitly disclose providing a sum of actual

application values and a sum of base application values. However, Feria et al. discloses base and

ongoing costs, where base costs measure the cost of implementing the system. Ongoing costs on

the other hand are the total amount of expenses of running the IT (C. 3, lines 1-18). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

modify the method of Feria et al. and include base and ongoing costs, because the two values

represent the cost of implementing the potential system while the other is the cost of running the

system, respectively, which provides the user with opportunities to make a decision based on

different scenarios.

As per **Claims 34-35**, Feria et al. fails to disclose increasing said actual application value

of each application by the value of the highest optimized business value of an enablement

attribute construct corresponding with respective said applications to provide maximum business

values for said applications, and summing the maximum business values of said applications to

provide a sum of maximum business values. However, Abu El Ata et al. teaches business values

that are associated with business infrastructure, where a ceiling threshold is a maximum a value

can be. When a value is too low that value can be analyzed to determine which metrics are

causing the low value (0053). Therefore, it would have been obvious to one of ordinary skill in

the art at the time of applicant's invention to modify the method of Feria et al. and include

providing a ceiling threshold in which the business value can attain as taught by Abu El Ata et

al., because it allows the user to determine a value that when reached can be analyzed to

determine the cause of the threshold being reached.

As per **Claim 36**, Feria et al. discloses deriving said operational cost of each application

in correspondence with its associated line of business costs; and including the step of: (I)

summing the line of business costs of said applications to provide a sum of line of business costs

(C.1, lines 40-46).

As per **Claim 37**, Feria et al. discloses deriving said operational cost of each application

in correspondence with its associated information technology costs; and including the step of:

(m) summing the information technology costs of said applications to provide a sum of

information technology costs (C. 1, lines 40-46).

As per **Claim 39**, Feria et al. discloses deriving said base application value as the loaded

costs of active concurrent users of the application for a given time interval (C. 1, lines 40-47).

As per **Claim 40**, Feria et al. discloses determining said perceived value of an enablement

attribute construct as including the value of availability of said application with respect to said

applied variation (C. 9, line 61 – C. 10, line 16; C. 14, line 54- C.15, line 4).

As per **Claim 41**, Feria et al. discloses determining said perceived values of an

enablement attribute construct as including the value of flexibility of said application with

respect to said applied variation (C. 17, lines 11-15).

As per **Claim 42**, Feria et al. discloses determining said perceived value of enablement

attribute contract as including the value of security of said application with respect to said

applied variation (C. 5, lines 63-67).

As per **Claim 43**, Feria et al. discloses providing said application use cost construct as

including the cost of said infrastructure corresponding with said application (C. 5, line 24 – C.

6,line 9).

As per **Claim 44**, Feria et al. discloses providing said application use cost construct as

including the cost of said support of the application use of said infrastructure (C. 8, lines 27-36).

As per **Claim 45**, Feria et al. fails to explicitly disclose providing said application use

cost as said cost of active concurrent users of the application for a single working day. However,

Feria et al. discloses determining the cost of each end user (C. 1, lines 40-47). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Feria et al. and include determining the cost of end users for any amount of time, because it allows the user to determine value metrics on specified time metrics.

As per **Claim 46**, Feria et al. discloses deriving said operational cost of said application in correspondence with line of business costs (C. 1, lines 40-47).

As per **Claim 47**, Feria et al. discloses deriving said operational cost of said application in correspondence with information technology costs (C. 1, lines 40-47).

As per **Claim 48**, Feria et al. discloses deriving said operational cost of said application in correspondence with: the desk top cost of computer hardware and software; staff operational cost; the effective cost of computer hardware and software storage; and the effective cost of computer hardware and software servers (C. 5, line 25- C. 6, line 9).

As per **Claim 49**, Feria et al. discloses deriving said operational cost of said application in correspondence with: the effective cost of database software; the effective cost of application software; the effective cost of computer network hardware and software; and the effective cost of services (C. 5, line 23 – C. 6, line 40).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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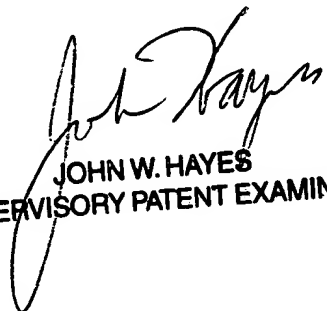
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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER